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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/685,505

Filing Date: October 16, 2003

Appellant(s): NOEL ET AL.

RICHARD L. TREANOR
JEFFREY B. MCINTYRE
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on March 29, 2011 appealing from the Office action mailed September 30, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1, 6, 8-18 and 20 are pending and rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

US 6,346,255	FONTINOS	2-2002
US 6,465,402	LORANT et al.	10-2002
EP 1055406	LORANT et al.	11-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 8-18 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lorant et al. (EP 1055406 or US 6,465,402, the English equivalent) in view of Fotinos (US 6,346,255).

Lorant teaches an oil-in-water emulsion comprising an organopolysiloxane elastomer in the oily phase and a water-soluble polymer in the aqueous phase. The

prior art oil-in-water emulsions are stable and do not contain any conventionally used surfactant. See col. 2, lines 12-28; instant claim 1. Lorant teaches emulsifiers are potentially irritating the skin, eyes and scalp and thus it is advantageous to formulate an emulsion without using emulsifiers to stabilize the emulsion. The compositions provide fresh and comfortable feel during application to the skin, unlike conventional compositions. See abstract and column 1, lines 18-36.

Lorant teaches the use of α, ω dimethylvinylpolydimethylsiloxane. See column 4, line 50. The elastomer gel is utilized in an amount of 0.03-40% and preferably 1.5-20%. See column 5, lines 59-66; instant claims 8-10. The water-soluble polymers that are suitable include carboxyvinyl polymers; acrylic or methacrylic copolymers; natural gums; polysaccharides; acrylamide polymers and copolymers; vinyl ether copolymers; or cationic polymers, such as polyquaternium. Preferable acrylamide copolymers include the crosslinked copolymer of acrylamide and of 2-acrylamido-2-methylpropanesulphonic acid (AMPS), in particular the mixture sold under the name Sepigel 305; instant claims 12-15. The polymer is used in an amount from 0.1 to 10%, preferably 0.2 to 5%, and more preferably from 0.5 to 2%. See column 6, line 5 to column 9, line 40; instant claim 16. The oils in the oil phase include non-volatile and volatile oils; the oily phase can range from 1 to 50%. See column 9, line 40 to column 10, line 25; instant claims 17-18. The composition comprises active agent in the amount of 0.01-30%, which may be antioxidants, lipophilic active agents, etc. Preferably the active agents include moisturizing agents; keratolytic agents; salicylic acid and its derivatives; vitamins; depigmenting agents; slimming agents; screening

agents; and any active principle appropriate for the final purpose of the composition.

See column 10, lines 32-60. The composition is suitable for treating dry skin and/or dry lips. See column 11, lines 1-7.

Lorant does not teach the use of the instant lipophilic amino acids.

Fotinos teaches a method of improving skin appearance with a skin permeation enhancer and an active agent. See abstract. Fotinos teaches the use of various lipoamino acids such as acylation products, which are anti-elastase and anti-collagenase agents (anti-wrinkle agents); the use of lipoamino acids such as lysine and lauroylmethionine as antioxidants; lipoamino acids such as instant capryloylglycine as seboregulators; lipoamino acids such as lysine PCA and related compound as hydratives. See column 7, lines 36-65. Examples 37-40 teaches cosmetic pads containing seboregulators, wherein the active ingredient is used at 1 % w/w on a dry basis and at 16.13 % by weight of coating compositions. See examples 38 and 40. The reference also indicates that cosmetic actives are typically present in cosmetic pads in an amount of 1-20 % by weight. See col. 8, lines 38 – 55; instant claim 6. Furthermore, the reference teaches that it is a conventional practice in cosmetic art to formulate cosmetic agents in various forms, either in lotion or patches. See col. 4, lines 60-66. Thus discovering the workable effective amount for the seboregulators in a liquid vehicle would have been well within the skill of the art.

It would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the teaching of Lorant and Fotinos and utilize lipoamino

acids as the active agent in Lorant's composition. One would have been motivated to do so since Fontinos teaches lipoamino acids have a large number of applications in the cosmetic field including anti-wrinkle agents, antioxidants, hydrating agents, and seboregulators and Lorant teaches the use of any skin active agent including antioxidants and moisturizing agents, depending on the final purpose of the composition. Therefore, the selection of the active agent is *prima facie* obvious depending on the desired aesthetic benefit provided by the skin care composition. Furthermore, a skilled artisan would have been motivated to use capryloylglycine in particular if one desired to provide a composition that controls sebum, which causes acne.

With respect to claim 6, finding a workable weight amount of capryloylglycine in the Lorant emulsion would have been well within the skill of the art. The court in *In re Aller* has stated, "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." See 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In the present case, the Fontinos teaches the general range of cosmetic active ingredient for cosmetic patch or pad, and teaches that seboregulators are used in 16.13 % by weight of a coating composition or 1 % by dry weight. Also suggested in the reference is the conventional practice in cosmetic art that same cosmetic actives are incorporated into different formulations, such as lotion. Since Fontinos teaches capryloylglycine is used in cosmetics to control sebum, the parameter for the optimization of the weight amount is clearly taught. Thus discovering the optimum weight amount of the capryloylglycine as

a sebum regulator in the Lorant silicone emulsion would only take routine experimentations in the art.

(10) Response to Argument

A. Claims 1, 6, 8-18 and 20 have been properly rejected under 35 U.S.C. § 103

(a) over Lorant in view of Fontinos.

Appellant argues 1) that oil-in-water emulsions containing at least 1 % elastomeric organopolysiloxane and hydrophilic polymer(s) tend toward destabilization; and 2) that adding capryloylglycine and/or undecylenoylglycine to such oil-in-water emulsion of a specific type of elastomeric organopolysiloxane and hydrophilic polymer(s) improve stability of the emulsions even in the absence of stabilizing effective amounts of surfactant. Appellant argues that the cited references fail to teach or suggest "specific, glycine derivative-stabilized, non-irritating emulsions" of the instant claims.

However, Lorant discloses stabilization of oil-in-water emulsions containing at least 1 wt % of Appellant's silicone elastomers and the same hydrophilic nonionic polymers of the instant claims. Examiner respectfully points out that the elastomeric organopolysiloxane and the hydrophilic polymers of instant claims are plainly disclosed and used in the Lorant examples of stabilized, surfactant-less oil-in-water emulsions. As indicated in the rejection, the reference teaches the silicone elastomers of instant claim 1 in col. 4, lines 36 – 49,

The organopolysiloxane elastomers used according to the invention can be preferably chosen from the crosslinked polymers obtained by an addition and

crosslinking reaction in a non-aqueous medium, in the presence of a catalyst, preferably of the platinum type (i.e., of the platinum group as it is typically known in the art), at least:

- (a) one first organopolysiloxane *(i) having at least two vinyl groups in the α, ω -position in the silicone chain;* and
- (b) one second organopolysiloxane *(ii) having at least one hydrogen atom bonded to a silicone atom per molecule* and at least one oxyalkylene, in particular oxyethylene, group. (emphasis inserted).

The amount of the elastomer gel also ranges from 0.03-40% and preferably 1.5-20%, which is within the present claim limitation. As for the hydrophilic polymer of instant claim 1, it should be noted that there is no further limitation thereto. The hydrophilic polymers of dependent claims 12-14 include the crosslinked 2-acrylamido-2-methylpropanesulphonic acid (AMPS), which was also mentioned in the rejection. The objective of the Lorant patent was to stabilize an oil-in-water emulsion with the disclosed elastomeric organopolysiloxane in the oil phase and the water soluble or swellable polymer in the aqueous phase, without using any surfactants. See col. 2, lines 12-28. Thus appellant's argument that the glycine derivatives of the present claims is necessary to stabilize the same emulsion as disclosed by the prior art is unpersuasive. According to the Lorant patent, the prior art oil-in-water emulsions are stable without surfactants or the glycine derivatives of instant claim.

In response to appellant's assertion that the presently claimed emulsion is non-irritating, examiner notes that such is not a claim limitation, and Lorant in fact suggests the prior art emulsion, which is made without surfactants, is non-irritating. See Lorant, col. 1, lines 34-36; col. 2, lines 54 - 60.

Appellant argues that a *prima facie* case of obviousness would require Fontino to recognize the alleged property of glycine to stabilize elastomer-containing emulsions. Appellant states, "the applied art generally suggests that such glycine derivatives could optionally be added to compositions for some other purposes". In response, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, the disclosed, well-known use of capryloylglycine as a seboregulators would have taught, suggested and motivated a person of ordinary skill in the art to select this specific glycine derivative to make a seboregulator composition and renders the presently claimed subject matter *prima facie* obvious. Pursuant to *Ex Parte Obiaya*, applicant' discovery of another advantage of the same glycine derivative cannot be basis for patentability. This is particularly true in the present case, since it has been known that o/w emulsion stabilization is achieved by other ingredients of the emulsion.

Appellant also argues that the rejection fails to mention the required glycine derivatives are present in an amount effective to stabilize the composition. Citing *Abbott Lab. v. Baxter Pharm. Products, Inc.*, appellant argues that "the applied art would have to disclose or suggest actually stabilizing an elastomer-containing, surfactant-less emulsions". See 67 U.S.P.Q. 2d 1191 (Fed. Cir. 2003). In response, examiner reiterates that Lorant has shown emulsion stabilization is achieved without the glycine derivatives. Appellant has disclosed a range of 0.1-20 wt % of the glycine derivatives

be used, and admitted in claim 6 that this range is within the amount effective to stabilize the emulsion. In the rejection, examiner had indicated that Fontinos teaches using 1-20 wt % of the disclosed cosmetic ingredients. Using capryloylglycine in an amount ranging from 1-20 wt %, which overlaps with the present claim limitation, would have been obvious to a person of ordinary skill in the art. In view of the Fontinos teaching of the well-known cosmetic utility of capryloylglycine as a seboregulator, a person of ordinary skill in the art would have been motivated to use this active agent in cosmetic compositions within the disclosed amount with a reasonable expectation of success. Thus, incorporation of capryloylglycine to a cosmetic emulsion comprising the silicone elastomer and hydrophilic polymer of Lorant would have been *prima facie* obvious to a person of ordinary skill in the art.

B. Appellant's evidence fails to show unexpected result

Relying on examples 3-6 of the instant specification and the Rule 132 declarations submitted on July 24, 2007 and November 1 2006, appellant asserts evidence shows unexpected property of the claimed glycine derivatives to stabilize o/w emulsions containing at least 1 % elastomeric organopolysiloxane and hydrophilic polymers without depending on surfactants.

Such assertion contradicts the prior art disclosure of Lorant, which shows stabilization of oil-in-water emulsions is achieved by utilizing (1) the same elastomeric organopolysiloxane of appellant's invention in an amount greater than 1% and (2) the same hydrophilic polymers of the instant invention. In response to appellant's arguments based on the declarations, examiner respectfully points out Lorant Example

4, a surfactant-free o/w emulsion comprising the elastomeric organopolysiloxane of instant claims (1.32 % active) and the same crosslinked 2-acrylamido-2-methylpropanesulphonic acid of the present invention. At no time during this prosecution appellant has disputed the examiner's findings that the prior art silicone elastomer and hydrophilic polymer are the same ingredients of the instant claims. Nor has appellant provided any explanation for the apparent discrepancy of the prior art disclosure and appellant's assertion. In view of all evidence on the record, examiner is of the opinion that appellant's data fails to overcome the *prima facie* case of obviousness in this case.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/GINA C. YU/
Primary Examiner, Art Unit 1617

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